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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/074,683 05/08/98 VAN RYZIN

J 50L2090

EXAMINER

TM02/0321

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HOMERE J
ART UNIT PAPER NUMBER

2177
DATE MAILED:

03/21/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/074,683

Applicant(s)

Van Ryzin

Examiner

Jean R. Homere

Group Art Unit

2177



☒ Responsive to communication(s) filed on Jan 5, 2001

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) ~~1-14, 16-25~~ 1-14, 16-25 is/are pending in the application

Of the above, claim(s) none is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) ~~1-14, 16-25~~ 1-14, 16-25 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Response to Amendment

1. Applicant's arguments with respect to claims 1-14, 16-25 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-14, 16-25 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01.

Claim 1 has no metes and bounds. The body of the claim is not functionally tied to the invention as set forth in the preamble. The preamble of the claim sets forth a method for utilizing a custom playlist. The body of the claim, however, merely recites the steps of creating the custom playlist, providing the custom playlist to an actuator device, and saving the custom playlist in a virtual CD. As drafted, the steps recited in the body of the claim fail to logically amount to the task of utilizing the custom playlist, as posed in the preamble. As claimed, the invention encompasses any and all manners of utilizing the custom playlist. Correction is requested.

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4. Claims 2-14, 16-25 are rejected for fully incorporating the deficiencies of the base claim by dependency.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-14, 16-25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of copending Application No. 09/074,681. Although the conflicting claims are not identical, they are not patentably distinct from each other. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter. Furthermore, there is no apparent reason why applicant would be prevented from

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presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

7. Claims 1-14, 16-25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of copending Application No. 09/074,681. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art of data processing to modify the invention as instantly claimed since such modification would not have interfered with the functionality of the method as claimed in the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claims 1-14, 16-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Douma et al. ('Douma' hereinafter), U.S. Patent No.5,990,884, in view of Montoya et al ('Montoya', hereinafter), U.S. Patent No.5,949,688.

As to claims 1-2, Douma substantially discloses the invention including a PC having a CPU, a storage medium and audio visual accessing capability (col.4, lines 1-8, et seq). In particular, Douma discloses the creation of a custom playlist on an external device (col.2, lines 47-49 et seq). Further, Douma discloses the transfer of the custom playlist to a digital audio/visual device (col.2, lines 54-61 et seq). Additionally, Douma discloses a data storage medium physically connected on the PC for storing selected audio titles, wherein said storage medium can be searched according to plurality of attributes (col.4, lines 1-27, et seq). Douma also discloses a GUI for allowing users to interface with the recording medium (col.5, lines 12-15, et seq).

Douma does not particularly detail the saving of the customized playlist on a virtual CD, which is capable of being modified upon demand. However, Montoya discloses an analogous system for allowing customers to compile a series of desired tracks on a CD recording unit, whereby a customer scans the available titles and selects the desired tracks therefrom to thereby generate a desired playlist on the CD (col.3, lines 2-13 et seq), and whereby the selections on the CD can be modified/updated upon user's request (col.4, lines 33-36 et seq). It would have been obvious to one of ordinary skill in the art of data processing to combine the teachings of the cited

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references. Montoya's teachings would have allowed users of Douma's system to be able to customize a CD according to their volition.

As to claim 3, Douma discloses the collection of tracks to be obtained by the actuation device from an external source (col.3, lines 52-56, et seq).

As to claims 4, 8, Douma discloses the reading of table of contents of each source medium to obtain information about the plurality of tracks (col.4, lines 30-41, et seq).

As to claim 5, Douma discloses a two way communication link with the external device (fig.1, items 24, 28, et seq).

As to claim 6, Douma discloses the Internet as the external information source (fig.1, item 22, et seq).

As to claim 7, Douma discloses searching a plurality of tracks for titles and track names stored in the DB of a PC (col.4, lines 1-4, et seq).

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As to claim 10, Douma discloses the downloading of the selected file to the actuation device over a communication link, whereby said downloaded file is stored locally on the actuation device (col.6, lines 21-26 et seq).

As to claims 11-13, Douma discloses cable, infra red and wireless as possible communication links (col.6, lines 41-50 et seq).

As to claim 23, Douma discloses the retrieval and selection of information about a plurality of tracks that are available to be added to a custom list (col.4, lines 14-28, et seq). Further, Douma discloses table of contents (TOC) for identifying each disk or tape and the tracks available thereon (col.4, lines 37-41, et seq).

10. The limitations of claims 9, 14, 16- 22, 24-25 have already been addressed in the rejection of claims 1-8, 10-13 and 23 above. They are therefore rejected on similar grounds.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean R. Homere whose telephone number is (703)-308-6647. The examiner can normally be reached on Monday-Friday from 08:30 a.m.-5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene, can be reached on Monday-Friday from 8:00 a.m. to 3:30 p.m. at (703)-305-9790.

Any response to this action should be mailed to: Commissioner of Patents and Trademarks Washington, D.C. 20231, **or faxed to:** (703) 308-9051, (for formal communications intended for entry), **Or:** (703) 305-9731 (for informal or draft communications, please label "PROPOSED" or "DRAFT"). Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist). The facsimile phone number for this group is (703) 308-5357.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

Jean R. Homere
Jean R. Homere
Primary Examiner, A.U. 2177
March 13, 2001

JRH
JEAN R. HOMERE
PRIMARY EXAMINER